



Docket No.: 209396US2X

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

NORMAN F. OBLON
(703) 413-3000
NOBLON@OBLON.COM

ROBERT T. POUS
(703) 413-3000
RPOUS@OBLON.COM

RE: Application Serial No.: 09/874,057
Applicants: Takehiro NISHIYAMA
Filing Date: June 6, 2001
For: METHOD AND SYSTEM FOR RENTING A
CONSTRUCTION MACHINE
Group Art Unit: 3629
Examiner: RUHL, Dennis William

SIR:

Attached hereto for filing are the following papers:

REPLY BRIEF

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Norman F. Oblon

Registration No. 24,618

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

I:\ATTY\MB\20\209396US\209396_CVRLTR_REPLY BRIEF_DUE 13MAY07.DOC

Robert T. Pous
Registration No. 29,099

DOCKET NO: 209396US2X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

TAKEHIRO NISHIYAMA

SERIAL NO: 09/874,057

FILED: JUNE 6, 2001

FOR: METHOD AND SYSTEM FOR
RENTING A CONSTRUCTION MACHINE

:

: EXAMINER: RUHL, D.

:

: GROUP ART UNIT: 3629

:

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a reply to the Examiner's Answer mailed March 13, 2007 in response to an Appeal Brief filed January 22, 2007 appealing from the Final Office Action mailed September 26, 2006, for which a Notice of Appeal was timely filed on November 21, 2006.

I. STATUS OF CLAIMS

Claims 17-21 are pending in this application. Claims 17-21 were rejected in the September 26, 2006 Office Action.

Claims 1-16 and 22 have been canceled.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection to be reviewed on appeal and outstanding in the present application is of (1) Claims 17-21 under 35 U.S.C. § 112, second paragraph; (2) Claims 17-21 under 35 U.S.C. § 102(b) over USP 5,754,850 to Janssen; and (3) Claims 17-21 under 35

U.S.C. § 103(a) over Janssen in view of *United Rentals Inc. Launches Business to Business Equipment E-Rental Store*, PR Newswire Association Inc., February 3, 2000.

III. ARGUMENT

A. First Rejection

The Examiner's Answer asserts that Claim 17's recitation of "under course of or out of operation" does not make any sense. In particular "under course of" is separated from "or out of operation." Clearly the claim recitation is intended to mean "under course of operation" or "out of operation." The Reply Brief's assertion that Applicant argued that the language of "under course of" refers to "in course of maintenance" is incorrect. Page 11, lines 19-20 of the specification indicates that "in course of out of operation" refers to in course of maintenance. Thus, "under course of operation" refers to when no maintenance is being performed.

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 C.F.R. § 1.75(d)(1).

Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005). Thus, Applicant asserts that the claim language is clear and supported by the specification.

B. Second and Third Rejections

The Examiner's Answer asserts that Claim 17 recitation of "means for providing" is satisfied by the hardware and software of Janssen that allows the search result to be sent to the second terminal including a modem and a modem driver software. The Answer also asserts that the specification provides no support for the "means for providing" except for a network. Thus, the Examiner's Answer continues to only consider the portion of Claim 17 which recites "means for providing" without considering the remaining part of the recitation. Specifically "means for providing the second network terminal with the information related to the construction machine for rent as a calendar displaying information related to the rental situation of the construction machine for rent, the rental situation including whether the construction machine is rented, vacant, under course of negotiations and under course of or out of operation at least during a period corresponding to the rental period inputted through the second network terminal."

Applicant notes that Claim 17 recites "a network server" including the "means for providing." Furthermore, the specification at page 6, line 2 refers to the network server. Thus, the means for providing is clearly a server, such as a computer or microprocessor, programmed to carry out the function of providing the second network terminal with the information related to the construction machine for rent as a calendar displaying information related to the rental situation of the construction machine for rent, the rental situation including whether the construction machine is rented, vacant, under course of negotiations and under a course of or out of operation at least during a period corresponding to the rental period inputted through the second network terminal and not only delivering data to the second network terminal. Neither Janssen nor *United Rentals* discloses these features.

The Examiner's Answer asserts that the original language of Claim 17 limits the current recitation of Claim 17. The original language of Claim 17 "means for providing a

searched result by the searching means to the second network terminal through the network” does not contradict the “means for providing” as a part of a network server i.e. a special purpose computer programmed to perform the disclosed algorithm. Furthermore, the original Claim 17 recited a “network server” including the “means for providing.”

The Office Action asserts that under 37 C.F.R. § 1.111 Applicant’s failure to traverse the previous rejection of original Claim 11 precludes Applicant’s current traversal of Claim 17. Applicant notes that original Claim 11 is directed to a method wherein the network server provides the person with the information related to the rentable construction machine as a calendar including information related to the rental situation of the construction machine for rent. Thus, Claim 11 is directed to a method whereas Claim 17 is directed to an apparatus. Furthermore, the scope of the claims is different.

Neither Janssen nor *United Rentals Inc.* disclose means for providing the second network terminal with the information related to the construction machine for rent as a calendar displaying information related to the rental situation of the construction machine for rent, the rental situation including whether the construction machine is rented, vacant, under course of negotiations or out of operation at least during a period corresponding to the rental period inputted through the second network terminal as in amended independent Claim 17.

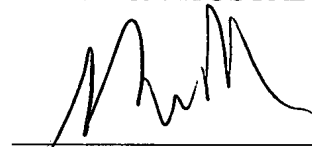
As discussed above Janssen does not disclose the structure of independent Claim 17. *United Rentals* does not provide the deficiencies of Janssen. *United Rentals* does not disclose information related to the construction machine for rent including whether the construction machine is “under course of negotiations and under course of or out of operation.” As disclosed in the specification at page 11, lines 9-21 in the calendar display shown in Figure 5 operating situations of various types of machines are displayed. The operating situations are displayed separately in the form of any one of the course of rental, in course of vacant, in the course of negotiations, and in course of operation (in course of maintenance). *United Rentals*

Inc. discloses customers may rent and buy equipment on line review specifications of equipment available for rent, as well as browse through listings of used equipment including equipment specifications photos and operating histories. Additional users can access summaries of equipment they have out on rent, the rental rates and the status of their account. There is no information related to under course of negotiations and under course of or out of operation as well as to providing this information on a calendar. The Office Action states that the claimed data would naturally flow from the fact that the intended use of the system is for the rental of the constructions machines. However, this is impermissible hindsight reasoning using the Applicant's disclosure. To establish a *prima facie* case of obviousness the prior art references must teach or suggest all the claim limitations. Thus, even if Janssen and *United Rentals* would be combined the features of Claim 17 are not disclosed.

In view of the foregoing comments, each of the pending Claims 17-21 clearly distinguish over the applied art references, and thus the outstanding rejections must be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Robert T. Pous
Registration No. 29,099

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)

GJM:RTP:MB\dt\pch
I:\ATTY\MB\20's\209396US\209396US-REPLY BRIEF DUE 13MAY07.DOC